



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,012	02/09/2004	Michael C. Wood	020824-004112US	9083
20350 7590 03/20/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
SAADAT, CAMERON				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
03/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/776,012

Applicant(s)

WOOD ET AL.

Examiner

CAMERON SAADAT

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 12/20/2007.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 1-15 are pending in this application.

Terminal Disclaimer

The terminal disclaimer filed on 12/14/2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of patent no. 7,083,420 has been reviewed and is accepted. The terminal disclaimer has been recorded. Accordingly, the obviousness-type double patenting rejection set forth in the previous office action is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4, 9-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,042,478).

Claim 1: Ng discloses an interactive, handheld apparatus comprising: a game unit housing 50; a display screen 52 on the housing, the display screen configured to display a

Art Unit: 3714

plurality of images; an electronic position location system, wherein the electronic position location system includes a processor that is capable of determining a location of a selected region of the display screen (See Col. 6, lines 56-60); a stylus 60 for selecting one or more of the plurality of images on the display screen; a directional control pad on the housing (multiposition switch 56, see Fig. 1); a memory cartridge devices 81 and 82 comprising computer code, wherein the memory device is operatively coupled to the processor (See Col. 3, lines 42-61); and a light associated with the stylus (See Col. 6, The game unit displays icons 72 and 73 on LCD display 52 to announce the availability of applications for a user to select with a stylus).

Ng does not explicitly disclose the claimed intended use limitations: "code for an educational program" and "to indicate that the stylus is available for use during operation of the educational program". However, A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if the prior art has the capability to so perform. See MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (1987). In this case, the claimed handheld apparatus is intended for an educational program. However, the intended use of the claimed invention does not result in a structural difference between the handheld apparatus and the game unit of the prior art, and therefore is not patentably distinguishable from the prior art.

Claim 2: Ng discloses a light (display screen 52) associated with the directional control pad 56. It is the examiner's position that the intended use of illuminating the light "to indicate that the directional control pad is available for use during operation of the educational program" does not result in a structural difference between the handheld apparatus and the game unit of the prior art, and therefore is not patentably distinguishable from the prior art.

Claims 3 and 15: Ng does not explicitly disclose the use of vector graphics. However, the Examiner takes official notice that the use of vector graphics is old and well known for being advantageous over raster graphics for having smaller file sizes and allowing for photo realistic

Art Unit: 3714

images. Therefore, it would have been obvious to one of ordinary skill in the art to modify the graphics described in Ng, by providing vector graphics for the advantages described above.

Claim 4: Ng discloses a memory device that is a removable cartridge. See Col. 3, lines 57-61.

Claims 9-10 Ng discloses a game unit housing 50; a display screen 52 on the housing, the display screen configured to display a plurality of images; an electronic position location system, wherein the electronic position location system includes a processor that is capable of determining a location of a selected region of the display screen (See Col. 6, lines 56-60); a stylus 60 for selecting one or more of the plurality of images on the display screen; a directional control pad on the housing (multiposition switch 56, see Fig. 1); a memory device 81 and 82 comprising computer code, wherein the memory device is operatively coupled to the processor; a light associated with the stylus (See Col. 6, The game unit displays icons 72 and 73 on LCD display 52 to announce the availability of applications for a user to select with a stylus).

Ng does not explicitly disclose the claimed intended use limitations: code *for* an educational program. However, A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if the prior art has the capability to so perform. See MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (1987). In this case, the claimed handheld apparatus is intended for an educational program. However, the intended use of the claimed invention does not result in a structural difference between the handheld apparatus and the game unit of the prior art, and therefore is not patentably distinguishable from the prior art.

Claim 11: Ng does not explicitly disclose an educational program for painting or a game that teaches about letters or spelling. However, the Examiner takes official notice that teaching a child about painting, spelling, or any other topic is old and well known for exposing a child to a variety of topics, and it would have been obvious to an artisan to utilize an educational

Art Unit: 3714

program of any topic on the apparatus described in Ng, in order to learn about various topics of interest.

Claim 12: Ng discloses a first light associated with the stylus and a second light associated with the directional control pad (multiposition switch 56, see Fig. 1. See Col. 6, the game unit displays icons 72 and 73 on LCD display 52 to announce the availability of applications for a user to select with a stylus.

Claim 13: Ng does not explicitly disclose a trapezoidal housing. However, it is the examiner's position that it would have been an obvious matter of design choice as to the shape of the housing, wherein no stated problem is solved or unexpected result is obtained by prescribing a trapezoidal housing.

Claims 5-8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,042,478) in view of Wood et al. (US 6,608,618; hereinafter Wood

Claim 5: Ng discloses an interactive, handheld apparatus comprising: a game unit housing 50; a display screen 52 on the housing, the display screen configured to display a plurality of images; an electronic position location system, wherein the electronic position location system includes a processor that is capable of determining a location of a selected region of the display screen (See Col. 6, lines 56-60); a stylus 60 for selecting one or more of the plurality of images on the display screen; a directional control pad on the housing (multiposition switch 56, see Fig. 1); a memory device 81 and 82 comprising computer code, wherein the memory device is operatively coupled to the processor; a light associated with the stylus (See Col. 6, The game unit displays icons 72 and 73 on LCD display 52 to announce the availability of applications for a user to select with a stylus).

Ng does not explicitly disclose control logic configured to control illumination of the light, wherein the light is illuminated at specific points during the course of the educational game to indicate that the stylus is available for use. However, Wood teaches an interactive

Art Unit: 3714

apparatus comprising a stylus 35 (see fig. 1), wherein a user is audibly prompted for a response with a stylus (marking tool) at specific points during the course of an educational game. See Co. 5, lines 1-13. Thus, in view of Wood, it would have been obvious to one of ordinary skill in the art to utilize the apparatus described in Ng, for use with an educational program, and providing prompts to use the stylus during the educational program, in order to provide an interactive device that elicits a response from the user.

Claim 6: Ng does not explicitly disclose control logic configured to control illumination of the light associated with the directional control pad, wherein the light associated with the directional control pad is illuminated at specific points during the course of the educational game to indicate that the directional control pad is available for use. However, Wood teaches an interactive apparatus wherein a user is prompted to select a button during the progression of an educational program. See Wood, Col. 5, lines 20-28. Thus, in view of Wood, it would have been obvious to one of ordinary skill in the art to utilize the apparatus described in Ng, for use with an educational program, and providing prompts to use the directional control pad during the educational program, in order to provide an interactive device that elicits a response from the user.

Claim 7: Ng does not explicitly disclose the use of vector graphics. However, the Examiner takes official notice that the use of vector graphics is old and well known for being advantageous over raster graphics for having smaller file sizes and allowing for photo realistic images. Therefore, it would have been obvious to one of ordinary skill in the art to modify the graphics described in Ng, by providing vector graphics for the advantages described above.

Claim 8: Ng discloses a memory device that is a removable cartridge. See Col. 3, lines 57-61.

Claim 14: Ng does not disclose the claimed feature of providing a hint button coupled to the housing. However, Wood teaches an interactive educational device comprising a hint button. See Wood, Col. 5, lines 20-29. Thus, in view of Wood, it would have been obvious to one of ordinary skill in the art to modify the interactive device described in Ng by providing a hint button on the housing, in order to provide clues to a user, thereby helping the user learn about a given subject.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Ukita (US 5,477,510) – discloses an interactive device with stylus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAMERON SAADAT whose telephone number is (571)272-4443. The examiner can normally be reached on M-F 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cameron Saadat/
Examiner, Art Unit 3714
3/14/2008